REMARKS/ARGUMENTS

Applicant responds herein to the Office Action dated May 29, 2008.

Claims 1-5, 7-17 and 19-28 were pending in the Office Action with claim 1 being in independent form. By the present Amendment claims 4, 13, 19, 22, 23 and 28 have been amended to further clarify the features of the present application. Claims 1-3 have been canceled without prejudice or disclaimer. New claims 33-34 have been added.

Claims 1-5, 7, 9, 10, 19, 23 and 25 of the present application remain rejected under 35 U.S.C. §102(b) as allegedly being anticipated by Hashiguchi (6,063,103).

The Examiner contends that Hashiguchi discloses substantially all the features of claim 1, for example, of the present application. Applicants respectfully disagree.

As was noted previously, Hashiguchi, as understood by Applicants, relates to endoscope forceps that include an operating section for inputting an operating force and an insertion section which is fixably connected to the operating section and which can be inserted into a channel of an endoscope. An operating rod may also be inserted in the insertion section to be movable forward and backward. One end of the operating rod is connected to the operating section which is moved forward and backward by the operating force input to the operating section. A forceps section is exposed at the fore end of the insertion section. The forceps section includes jaws that are operated by the operating rod.

Claim 4, has been amended herein to include the subject matter of claims 1-3 and to specify that "the sheath is attached to the insertion section such that it is rotatable from a first position aligned with an axis of the insertion section to a second position where it is positioned at a predetermined angle relative to the axis of the insertion section, such that the extended portion of the sheath prevents the end effector from contacting biological tissue when the end effector rotates in a first direction different from the axial direction of the insertion section when the sheath is in the first position and the extended portion of the sheath prevents the end effecter from rotating in any direction when the sheath is in the second position." Support for these features can be found at least at pages 49-50 of the present application.

It is respectfully submitted that Hashiguchi does not disclose a sheath that is attached to the insertion section such that it is rotatable between two positions and such that "the extended portion of the sheath prevents the end effector from contacting biological tissue when the end effector rotates in a first direction different from the axial direction of the insertion section when the sheath is in the first position and the extended portion of the sheath prevents the end effecter from rotating in any direction when the sheath is in the second position," as is required by amended claim 4 of the present application. For this reasons alone, claim 4 should be allowable over the prior art.

Further, as has been previously pointed out with respect to previous claim 1, Hashiguchi does not disclose a surgical instrument including, "a support having a proximal end which supports the end effecter;" "a base member which has distal and proximal ends, and pivotally supports the proximal end of the support on the distal end to enable the end effecter and the support to be rotated together with respect to the base member;" "an elongate member which has a proximal end and a distal end at which the base member is located;" and "an extended portion which is disposed in the distal end of the elongate member to prevent one of forward rotation and backward rotation of the base member with respect to the support, and also to extend and cover at least one side of the base member." All of these limitations are also present in amended claim 4 as well.

The Examiner again contends that the jaws 4, 5 of Hashiguchi correspond to the "end effecter" of previous claim 1. The Examiner further argues that the pivot pin 14 in Hashiguchi corresponds to the "support" of claim 1 and that the operating rod 8 of Hashiguchi corresponds to the "base member" of previous claim 1. The Examiner further contends that the sheath 7 in Hashiguchi corresponds to the "elongate member" of previous claim 1 and that the support member 11 in Hashiguchi corresponds to the "extended portion" of the elongate member in previous claim 1. Applicants must again respectfully disagree.

As noted above, amended claim 4 of the present application requires, among other things, "a base member which has distal and proximal ends, and pivotally supports the proximal end of the support on the distal end to enable the end effecter and the support to be rotated together with

respect to the base member." That is, the end effecter and the support are rotated with respect to the base member.

In contrast, in Hashiguchi, the jaws, 4, 5, which the Examiner contends correspond to the claimed "end effecter" merely open and close. There is no disclosure in Hashiguchi that the jaws 4, 5 rotate relative to the operating rod 8, which the Examiner contends corresponds to the "base member." In response to this argument, the Examiner asserts that the jaws 4, 5 open and close as illustrated in Fig 4a and 4b. The Examiner argues that this movement is rotation. The Examiner further asserts that this rotation takes place with respect to base member 8. This is clearly incorrect. The jaws 4, 5 open and close. To the extent that this is "rotation" it is rotation with respect to the pin 14, which the Examiner argues is the "support" of claim 1, and not the "base member" as is required by claim 1.

As was also described in Applicants previous response, there is no disclosure in Hashiguchi that the jaws 4,5 and the pivot pin 14, which the Examiner contends corresponds to the "support" of previous claim 1, rotate relative to the operating rod 8 either. The pivot pin 14 merely allows the jaws 4,5 to open and close. It does not, however, enable the jaws 4, 5 and the pin 14 to be "rotated together with respect to the base member," as is required by the claims. The Examiner argues that Column 5, lines 19-29 disclose that the support 14 is capable of rotating relative to base member 8. This is incorrect. The portion of Hashiguchi cited by the Examiner merely describes how the pin 14 connects the jaw 4 to the operating rod 8. Specifically, Hashiguchi states "[T]he pivotal pin 14 connects the fore end section 81 of the operating rod 8 and the first jaw in a pivotable manner relative to each other." There is no disclosure here, or anywhere in Hashiguchi that the pin 14 rotates relative to rod 8, just that the jaw may pivot. Thus, Hashiguchi fails to disclose, "a base member which has distal and proximal ends, and pivotally supports the proximal end of the support on the distal end to enable the end effecter and the support to be rotated together with respect to the base member."

The support member 11 in Hashiguchi is covered by the sheath 7, but is not a part of the sheath 7. Thus, the support member 11 is not, "an extended portion which is disposed in the distal end of the elongate member," as is required by previous claim 1 and amended claim 4 herein. Further, there is no discussion in Hashiguchi that the support member 11 prevents

forward and backward rotation, or indeed, any movement of the rod 8 with respect to the pin 14. Indeed, to the contrary, the support member 11 is specifically designed to allow the rod 8 to move backward and forward therein to operate the jaws 4, 5. In addition, there is no disclosure in Hashiguchi to suggest that the support member 11 covers at least one side of the operating rod 8. Indeed, the rod 8 clearly extends beyond the end of the support member 11, which is indicated by reference numeral 11a and Figures 3A, 3B and 3C of Hashiguchi. Thus, Hashiguchi fails to disclose, "an extended portion which is disposed in the distal end of the elongate member to prevent one of forward rotation and backward rotation of the base member with respect to the support, and also to extend and cover at least one side of the base member," as is also required by amended claim 4 of the present application.

In response to these arguments, the Examiner argues that the claims do not require that the extended portion be a part of the elongate member. Applicants respectfully disagree as previous claim 1 and amended claim 4 specifically require "an extended portion disposed in the distal end of the elongate member." It would seem clear that the "extended portion" is an extended portion of the elongate member.

In response to Applicant's argument that the element 11 does not prevent forward and backward rotation of the rod 8 with respect to the pin, the Examiner merely states that the base member and the support 14 do not move forward and backward relative to another. However, the Examiner has still failed to identify any indication in Hashiguchi that the element 11 prevents forward and backward rotation of the element 8 with respect to the element 14. This is because, as is noted above, there is no rotation of the pin 14 relative to the element 8 at all.

Finally, with regard to the argument that the element 11 does not cover at least one side of the base member 8, the Examiner argues that the base member 8 is surrounded by the element 11. However, as is noted above, this is clearly incorrect since the rod 8 clearly extends beyond the end of the support member 11, and thus, is not completely covered by it. This is clear in Figs. 3A, 3B and 3C of Hashiguchi as well as in Figs. 4A and 4B cited by the Examiner

Accordingly, it is respectfully submitted that claim 4, and the claims depending therefrom, are also patentable over the cited art for these reasons as well

Claims 8 and 11 have been rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Hashiguchi, in view of Miyawaki et al. (6,066,151). Reconsideration of this rejection is respectfully requested.

Claims 8 and 11 depend from claim 4. As is noted above, it is believed that claim 4 is patentable over the cited art for at least the reasons described above. Further, it is respectfully submitted that claim 4 is patentable over the combination of Hashiguchi and Miyawaki, since Hashiguchi and Miyawaki, either alone or in combination, fail to show or suggest the patentable features of claim 4 described above.

Accordingly, it is respectfully submitted that claim 4, and the claims depending therefrom, including claims 8 and 11, are patentable over the cited art for at least the reasons described above.

Claims 15-16 have been rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Hashiguchi, in view of Lee and Miyawaki. Reconsideration of this rejection is respectfully requested.

Claims 15 and 16 depend indirectly from claim 4. As is noted above, it is believed that claim 4 is patentable over the combination of Hashiguchi and Miyawaki. Further, it is respectfully submitted that claim 4 is patentable over the combination of Hashiguchi, Lee and Miyawaki since none of these references, either alone or in combination, show or suggest the patentable features of claim 4 discussed above.

Accordingly, it is respectfully submitted that claim 4, and the claims depending therefrom, including claims 15-16, are patentable over the cited art for at least the reasons described above.

Claim 17 has been rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Hashiguchi in view of Miyawaki. Reconsideration of this rejection is respectfully requested.

Claim 17 depends from claim 4. As noted above, it is believed that claim 4 is patentable over a combination of Hashiguchi and Miyawaki. Thus, it is respectfully submitted that claim 17 is also patentable over the combination of Hashiguchi and Miyawaki since it depends on independent claim 4.

Claims 12, 13, 14, 20-22 and 26-28 have been rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Hashiguchi, in view of Lee. Reconsideration of this rejection is respectfully requested.

Claims 12, 13, 14, 20-22 and 26-28 depend either directly or indirectly from claim 4. As noted above, it is believed that claim 4 is patentable over Hashiguchi. Further, it is respectfully submitted that claim 4 is patentable over the combination of Hashiguchi and Lee since Hashiguchi and Lee, either alone or in combination, fail to show or suggest the patentable features of claim 4 described above.

Accordingly, it is respectfully submitted that claim 4, and the claims depending therefrom, including claims 12, 13, 14, 20, 22 and 26-28, are patentable over the cited art for at least the reasons described above.

Claims 1-5, 7, 9, 10, 12, 13, 14 and 17 have also been rejected under 35 U.S. C. 103(a) as allegedly being unpatentable over Hassler (5,374,277), in view of Japanese Patent Publication JP5-245153 (hereinafter the " Japanese Reference"). Reconsideration of this rejection is respectfully requested.

The Examine argues that Hassler discloses substantially all of the features of claim 1, but concedes that it does not teach an extended portion. The Examiner argues that the Japanese Reference discloses an elongate member with an extended portion that controls rotation of the end effecter. The Examiner further argues that it would have been obvious to one of ordinary skill in the art to modify Hassler to include the extended portion of the Japanese Reference. Applicants respectfully disagree.

As is noted above, claim 4 of the present application has been amended to specify that "the sheath is attached to the insertion section such that it is rotatable from a first position aligned with an axis of the insertion section to a second position where it is positioned at a predetermined angle relative to the axis of the insertion section, such that the extended portion of the sheath prevents the end effector from contacting biological tissue when the end effector rotates in a first direction different from the axial direction of the insertion section when the sheath is in the first position and the extended portion of the sheath prevents the end effecter from rotating in any

direction when the sheath is in the second position." Hassler and the Japanese Reference fail to disclose or to suggest such a sheath. Thus, claim 4 is patentable over these references.

Further, the Examiner argues that elements 60, 70 of Hassler correspond to the "end effecter" and that element 40 corresponds to the "support" of previous claim 1 and amended claim 4. The Examiner further argues that element 130 corresponds to a "base member" and that element 10 corresponds to an elongate member proximal to the base member. The Examiner argues that the Japanese Reference also discloses an elongate member 2 with an extended portion 2d that controls rotation of the end effector. This is also incorrect.

While the illustrations in the Japanese Reference are somewhat unclear, it would appear the element 2d thereof corresponds to a notch formed in the member 2 that allows to rotation of the end of the device upward as illustrated in Fig. 5. Thus, element 2d would not appear to be an extended portion of the element 2. Further, the portion of the element 2 that is opposite the notch 2d is also not an "extended portion" since it does not appear to prevent one of forward rotation and backward rotation of the base member with respect to the support, and does not extend to cover at least one side of the base member. As an initial matter, the element 10 on which the claws 3a, 3b are mounted can only be moved in one direction relative to the rest of the device, that is upward. Thus, the portion of the element 2 that is opposite the notch 2d does not prevent any kind of motion since no motion in this direction is possible. Further, as can be seen in Fig. 2, for example, of the Japanese Reference, the element 3 extends beyond the end of the element 2, and thus, is not completely covered.

Further, even if the Japanese Reference did disclose the extended portion of amended claim 2, which it does not, it would not have been obvious to modify Hassler to include this feature. Hassler already provides for limiting rotation of the end effecter through other means, for example, as illustrated in Fig. 14 and described at Column 10, lines 20-32 thereof. Thus, there would be no reason to make the modification of Hassler suggested by the Examiner.

Accordingly, it is respectfully submitted that claim 4, and the claims depending therefrom, are patentable over the cited art for at least the reasons describe above.

Claims 13, 19, 22, 23 and 28 have been amended in order to conform to amended claim 4. New claims 33 and 34 depend on claim 4 and merely include the subject matter of previous claims

6 and 18, respectively. Thus, these claims are also believed to be patentable over the cited art as well.

In light of the remarks and amendments made herein, it is respectfully submitted that claims 4-5, 7-17, 19-28 and 33-34 of the present application are patentable over the cited art and are in condition for allowance.

Favorable reconsideration of the present application is respectfully requested.

Accordingly, the Examiner is respectfully requested to reconsider the application, allow the claims as amended and pass this case to issue.

THIS CORRESPONDENCE IS BEING SUBMITTED ELECTRONICALLY THROUGH THE UNITED STATES PATENT AND TRADEMARK OFFICE EFS FILING SYSTEM ON OCTOBER 29, 2008

Respectfully submitted,

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